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EXAMINER

RAO, ANAND SHASHIKANT

ART UNIT	PAPER NUMBER
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2613

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/889,889
Filing Date: July 08, 1997
Appellant(s): SULLIVAN ET AL.

MAILED

JAN 27 2005

Technology Center 2600

Kurt M. Pankratz (#46,977)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 8/23/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellants' statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

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(6) Issues

The appellants' statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellants' statement in the brief that certain claims do not stand or fall together is not agreed with because although the group II claims 22-42 recite additional and separately patentable limitations from the group I claims 1-21, the appellant has failed to provide an argument supporting the differing limitations of the group II claims 22-42, and has supported the patentability of the group II with substantially the same arguments used in the supporting the group I claims 1-21. Accordingly, the Examiner asserts that claims 1-42 should stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,973,731	Schwab	10-1999
5,585,839	Ishida et al.	12-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 5-13, 15-24, 26-32, and 34-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwab. This rejection is set forth in a prior Office Action, mailed on 11/07/03.

Claims 4, 14, 25, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab in view of Ishida et al., (hereinafter referred to as "Ishida"). This rejection is set forth in a prior Office Action, mailed on 11/07/03.

(11) Response to Argument

Appellants' arguments filed with respect to claims 1-42 as filed in Paper 16 on 2/03/04 have been fully considered but they are not persuasive.

Claims 1-3, 9-13, 15-24, 26-32 and 34-42 remain rejected under 35 U.S.C. 102(e) as being anticipated by Schwab, (US Patent: 5,973,731 hereinafter referred to as "Schwab"), as was set forth in the Prior Office Action of Paper 15 mailed on 11/7/03.

Claims 4, 14, 25-26 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab in view of Ishida et al., (US Patent: 5,585,839 hereinafter referred to as "Ishida"), as was set forth in the Prior Office Action of Paper 15 mailed on 11/7/03.

The appellants present six arguments contending the Examiner's pending collective rejections of claims 1-3, 9-13, 15-24, 26-32 and 34-42 under 35 U.S.C. 102(e) as being anticipated by Schwab, (US Patent: 5,973,731 hereinafter referred to as "Schwab"), of claims 4, 14, 25-26 under 35 U.S.C. 103(a) as being unpatentable over Schwab in view of Ishida et al.,

(US Patent: 5,585,839 hereinafter referred to as “Ishida”). However, after a careful consideration of the arguments presented, and further analysis of the applied references, the Examiner must respectfully disagree for the reasons that follow.

After summarizing the appellants’ interpretation of Schwab (Brief: page 4, lines 1-33), the appellants argues that Schwab fails to read upon the “a client operable to perform a financial transaction...” as in claim 1 (Brief: page 5, lines 1-17; page 8, lines 15-31; page 9, lines 1-28), instead asserts that the Schwab citations in question establish an image database that is used in conjunction with a performed financial transaction, and not images of the financial transaction itself (Brief: page 5, lines 10-17). The Examiner respectfully disagrees. The citations in question establish that video is generated of the items and are then associated with the database record (Schwab: column 4, lines 23-27). Schwab establishes that the “items” to be images are “any product (new or used), service, or person to be listed within the database of this invention, and for which or whom image information is available for display based on a specific request...” (Schwab: column 4, lines 3-8). Schwab further establishes that the performing of a financial transaction is a disclosed service that is provided by the disclosed invention (Schwab: column 7, 8-11). Following this chain of logic, the Examiner asserts that Schwab images not only user images but financial transaction images, as well. It is noted that the appellants portray the Examiner as “piecing together various portions of Schwab’s disclosure...” to arrive the instant invention (Brief: page 5, lines 8-13). The Examiner respectfully disagrees. The Examiner was only following the chain of logic established by the reference itself, and further notes that the Examiner must consider what the entire reference teaches as a whole, and is not restricted to stitching together just bits and pieces of the Schwab reference, *In re Kuderna*, 165 USPQ 575

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(CCPA 1970), and taking into consideration the Schwab reference as a whole is what the Examiner has justifiably done. From the discussion above, the citation in question shows that the client generates data from a financial transaction or the image files generated from the transaction database at the client (Schwab: column 7, lines 22-25) and is transmitted to a financial transaction server which not only has a transaction database consisting of verification passwords, and associated image files (Schwab: column 7, lines 20-28). It is noted that the associated image files have to be of imaged transactions as discussed above. It is unclear to the Examiner how a transaction file server could be “named” as such, and not contain imaged financial transactions as this would go against the stated function of the disclosed element, itself. As to showing that the client itself performs said financial transaction, that is shown in Schwab as well. It is noted that Schwab discloses that the client is a transaction terminal (Schwab: column 7, lines 60-65), and further that this transaction terminal would be a financial terminal such as an ATM (Schwab: column 9, lines 23-43), as in the claims. Accordingly, the Examiner maintains that the limitation is met.

Secondly, the appellants argue that the Schwab reference fails to “...displaying the data and video in real time...” as in the claim (Brief: page 5, lines 18-33; page 6, lines 1-16). The Examiner respectfully disagrees. It is noted that Schwab discloses that the disclosed invention characterized by “utilizing a separate, centralized database to store data-compressed images of the subject individuals or items, and subsequently downloading the data-compressed images to local data terminals, on demand, *at the time* of the identification event or transaction...”

(Schwab: column 1, lines 40-45). The Examiner asserts that the *at the time* qualifier established

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by the reference reads on the “real time” limitation of the claimed invention, and thus this limitation is met as well.

After discussing the legal requirements for an obviousness rejection (Brief: page 6, lines 17-33) and summarizing the secondary Ishida reference (Brief: page 7, lines 1-5), the appellants argue that the rejection is based on improper hindsight reasoning (Brief: page 7, lines 10-13). The Examiner respectfully disagrees. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The Examiner notes that Schwab discloses using a video-phone transaction terminal to transmit both image/audio information to a central server (Schwab: column 2, lines 15-25). It is submitted that the disclosure of the a video-phone as the client or transaction terminal makes the incorporation of audio data obvious, and further shows that the Examiner didn't rely upon knowledge gleaned only from the applicant's disclosure, and thus the Examiner's reconstruction is proper.

Additionally, the appellants argue that the Examiner has failed to identify any motivation in the references to make the proposed combination (Brief: page 7, lines 6-9). It is noted that the courts have already ruled against this as requirement, In re Sheckler, 168 USPQ 716 (CCPA 1971). It is, course, not necessary that either Schwab or Ishida actually suggest, expressly or in so many words, the changes or improvements one of ordinary skill in the art would make, In re

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Rousselet, 52 CCPA 1533, 347 F. 2d 847, 146 USPQ 183 (965); *In re Rauen*, 53 CCPA 937, 356 F. 2d 125, 148 USPQ 554 (1996). It is noted that the Examiner has provided a motivation that one of ordinary skill in the art having full knowledge of the art's field of endeavor would derive from the teachings of the references, especially since Schwab discloses the use of "video-phones..." with the invention (Schwab: column 2, lines 1-25). And the Examiner must respectfully disagree with the appellants assertion that the mere mention of video-phones in no way suggests or motivates the combination with Ishida (Brief: page 7, lines 14-25). It is noted that since Schwab discloses knowledge of video-phone applications and further disclose possible incorporations of video-phones with the disclosed teaching, and since Ishida is a video-phone application for transaction processing, one of ordinary skill in the art would be compelled to consider the teachings of the secondary Ishida reference since they are analogous art, *In re Antle*, 170 USPQ 285, 287 (CCPA 1971). Accordingly, since Schwab are relevant towards each other, one of ordinary skill in the art would consider if the teachings of Ishida are applicable and desirable for incorporation with Schwab. Accordingly, the Examiner asserts that motivation if not directly provided from the references, would be provided by one of ordinary skill's full knowledge of the arts' fields of endeavor, and this field of endeavor would include both Schwab and Ishida since they pertain to technology of video-phones.

Furthermore, the appellants argue that the combination with respect to a reasonable expectation of success would fail (Brief: page 7, lines 26-33; page 8, lines 1-2). The Examiner respectfully disagrees. The Examiner notes that Schwab already foresees a possible requirement for audio confirmation of a transaction by the oral description of a confirmation symbol to a remote operator (Schwab: column 2, lines 13-18). The transmission of this oral description to

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verify a financial transaction would suggest to one of ordinary skill in the art a combination with Ishida. Also, it is noted that Schwab discloses the transmission of security/verification information with the financial transaction (Schwab: column 7, lines 20-25). One of ordinary skill in the art would associate a recorded voiceprint as a well known biometric authentication means along with those disclosed (Schwab: column 2, lines 8-13), and a voiceprint authentication feature would also require audio capabilities in Schwab. So, contrary to the appellants' assertion (Brief: page 7, lines 29-32), the Examiner would assert that there is a need for the Ishida teaching in Schwab, as discussed above. Additionally, it is noted that there isn't any limiting size requirement placed on the central image database that would preclude one of ordinary skill in art from also incorporating audio files with the image database, since the Examiner would further disagree that the scope and size of the data maintained would be unnecessarily expanded (Brief: page 7, lines 30-33).

Lastly, the appellants argue that even if the proposed combination were appropriate, the features of claim are still not met by the Ishida reference (Brief: page 8, lines 4-19). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Since the Examiner asserts that Schwab meets the "a client operable to perform a financial transaction..." and "real-time" limitations, those limitations with regards to the combination with Ishida would be met by Schwab and not need to be addressed by Ishida, which is only required to show the use of a microphone for generating an audio file.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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January 24, 2005

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